

REMARKS

Claims 11 and 13 are canceled without prejudice, claims 19 to 23 are added, and therefore claims 10, 12, and 14 to 23 are currently pending in the present application.

In view of this response, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraph two (2) of the Office Action, Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

With respect to paragraph three (3) of the Office Action, the paragraph beginning at page 13, line 33 (and ending at page 14, line 13) of the Specification has been amended without prejudice, as suggested. Approval and entry are respectfully requested. It is therefore respectfully requested that the objection be withdrawn.

With respect to paragraph three (3) of the Office Action, the Drawing of Figure 3 was objected to because of the labels of steps S1, S2, S3, S4 in Figure 3. Accordingly, accompanying this Amendment is a Replacement Sheet for Figure 3, which replaces "J" with --Y--, as suggested. No New matter has been added, and the text is supported by the present application. Approval and entry are respectfully requested. It is therefore respectfully requested that the objection be withdrawn.

With respect to paragraph five (5) of the Office Action, claims 10, and 12 to 14 were rejected under 35 U.S.C. § 102(b) as anticipated by European Patent Application Publication No. EP 1 304 251 ("Steinle et al.").

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Claim 13 has been canceled herein without prejudice.

While the rejections may not be agreed with, to facilitate matters, claim 10 has been rewritten to provide the feature that *the shutoff velocity is greater than 0 km/hr but less than 10 km/hr*.

Claim 10, as presented, relates to a cruise control system for a motor vehicle, including the features of a stop-and-go function adapted to automatically keep the vehicle stopped, a shutoff function adapted to automatically shut off the cruise control system when a brake pedal is being operated, the shutoff function non-operational if predefined conditions are met, including a condition that a velocity is not greater than a certain shutoff velocity, in which *the shutoff velocity is greater than 0 but less than 10 km/hr.*

The Steinle reference does not identically disclose (or even suggest) all of the features of claim 10, as presented. Instead, Steinle merely refers to deviating from the standard operation of switching off the speed monitoring system upon application of a brake by the driver when the vehicle is at a standstill. However, nowhere does Steinle et al. even refer to the shutoff function being non-operational if the vehicle is still moving -- e.g., at a velocity that is not greater than a shutoff velocity of greater than 0 but less than 10 km/hr. Therefore, Steinle does not identically disclose (or even suggest) all of the features of claim 10, as presented.

Accordingly, it is respectfully submitted that claim 10, as presented, is allowable. Claims 12 and 14 depend from claim 10, as presented, and are therefore allowable for at least the same reasons as claim 10, as presented.

Accordingly, it is respectfully submitted that claims 10, 12, and 14 are allowable.

Withdrawal of the rejections of the claims is therefore respectfully requested.

U.S. Pat. App. Ser. No. 10/584,230
Attorney Docket No. 10191/4553
Reply to Office Action of January 29, 2010

With respect to paragraph seven (7) of the Office Action, claim 11 was rejected under 35 U.S.C. § 103(a) as unpatentable over the Steinle reference.

While the rejection may not be agreed with, to facilitate matters, claim 11 has been canceled without prejudice. Withdrawal of the rejections of the claims is therefore respectfully requested.

With respect to paragraph eight (8) of the Office Action, claim 15 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Steinle et al. and U.S. Patent No. 5,771,481 (“Gilling”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As explained above, Steinle does not disclose (or even suggest) all of the features of claim 10, as presented. Claim 15 depends from claim 10, as presented, and it is therefore allowable for essentially the same reasons provided above, since Gilling does not cure - and is not asserted to cure - the critical deficiencies of the Steinle reference.

Withdrawal of the rejections of the claims is therefore respectfully requested.

U.S. Pat. App. Ser. No. 10/584,230
Attorney Docket No. 10191/4553
Reply to Office Action of January 29, 2010

With respect to paragraph nine (9) of the Office Action, claim 16 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Steinle et al. and U.S. Patent No. 5,749,427 (“Satonaka et al.”).

As explained above, Steinle et al. does not disclose (or even suggest) all of the features of claim 10, as presented. Claim 16 depends from claim 10, as presented, and is therefore allowable for essentially the same reasons provided above, since Satonaka et al. does not cure - and is not asserted to cure - the critical deficiencies of Steinle et al.

Withdrawal of the rejections of the claims is therefore respectfully requested.

With respect to paragraph ten (10) of the Office Action, claim 17 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Steinle et al. and U.S. Patent No. 4,867,288 (“Simonyi et al.”).

As explained above, Steinle et al. does not disclose (or even suggest) all of the features of claim 10, as presented. Claim 17 depends from claim 10, as presented, and is therefore allowable for essentially the same reasons provided above, since Simonyi et al. does not cure - and is not asserted to cure - the critical deficiencies of Steinle et al.

Withdrawal of the rejections of the claims is therefore respectfully requested.

With respect to paragraph eleven (11) of the Office Action, claim 18 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Steinle et al. and U.S. Patent No. 6,332,108 (“Hirasago”).

As explained above, Steinle et al. does not disclose (or even suggest) all of the features of claim 10, as presented. Claim 18 depends from claim 10, as presented, and is therefore allowable for essentially the same reasons provided above, since Hirasago does not cure - and is not asserted to cure - the critical deficiencies of Steinle et al.

Withdrawal of the rejections of the claims is therefore respectfully requested.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103

U.S. Pat. App. Ser. No. 10/584,230
Attorney Docket No. 10191/4553
Reply to Office Action of January 29, 2010

rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

In sum, claims 10, 12, and 14 to 18 are allowable.

New claims 19 to 23 do not add any new subject matter and are supported by the present application, including the specification. Claims 19 to 23 depend from claim 10, and they are therefore allowable for the same reasons, and for the further reason that they include combinations of features not disclosed or suggested by the applied references.

Accordingly, claims 10, 12, and 14 to 18 are allowable.

CONCLUSION

It is therefore respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

Dated: April 16, 2010

By: /Aaron C. Deditch/
Aaron C. Deditch, Reg. No. 33,865

For: Gerard A. Messina, Reg. No. 35,952

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646

1894931